

## **REMARKS**

The specification and claims 1, 52, 65 and 69 have been amended. No new matter has been added. For instance, support for the amendments of claims 1 and 52 appears e.g. at pages 6 and 11 of the application. Claim 65 has been amended without limitation to address a formality matter. Page 1 of the specification has been amended merely to update the status of the parent application.

At pages 2-3 of the Office Action, the priority claim at page 1 of the application is questioned based on the prior amendment to recite “continuation-in-part” rather than “continuation”.

Applicants traverse. Such amendment does not somehow change the propriety of the originally included priority claim at page 1 of the application. Indeed, 35 U.S.C. 120 merely states that the application include a “specific reference to the earlier filed application”. The statute does not somehow indicate that the priority claim can not be amended without jeopardizing the claim.

Claim 69 was rejected under 35 U.S.C. 102 over Jung et al. (GB 2320718).

Claim 69 was rejected under 35 U.S.C. 102(e) or, in the alternative under 35 U.S.C. 103 over Nishi et al. (U.S. Patent 6,566,038).

For the sake of brevity, the two rejections are addressed in combination. The rejections are traversed.

Applicants’ claim 69 recites subject matter of former claim 3, which was indicated to be allowable. In view thereof, withdrawal of the rejection is requested.

Claim 65 was rejected under 35 U.S.C. 112, second paragraph.

To expedite matters, claim 65 has been amended without limitation as recommended in the Office Action. It is thus believed the rejection is properly withdrawn.

Claims 1-5, 8, 23-24, 35, 41 and 46-68 were rejected under 35 U.S.C. 112, first paragraph. As grounds for the rejection, it is stated that independent claims 1 and 52 recite “oxynorbornyl” instead of “oxonorbornyl”.

To expedite matters, claims 1 and 52 have been amended to correct the typographical-type issue and recite “oxonorbornyl”. Withdrawal of the rejection is therefore requested.

Claims 1-2, 4-5, 23-24, 35, 41, 46, 48-54 and 56-68 were rejected under 35 U.S.C. 102 over Jung et al. (U.S. Patent 6,150,069). The rejection is traversed.

Jung U.S. Patent 6,150,069 is cited for a certain oxonorbornyl group.

Applicants’ independent claims 1 and 52 (the only independent claims rejected over Jung U.S. Patent 6,150,069) each calls for a heteroalicyclic group that is not an oxonorbornyl.

Such a heteroalicyclic group as Applicants claim is not disclosed or otherwise suggested by Jung U.S. Patent 6,150,069.

In view thereof, reconsideration and withdrawal of the rejection are requested.

Claims 1-2, 4-5, 24, 35, 41, 46, 48-50, 52-54 and 56-68 were rejected under 35 U.S.C. 102(e) or, in the alternative under 35 U.S.C. 103 over Nishi et al. (U.S. Patent 6,566,038). The rejection is traversed.

The Nishi document suffers from the same deficiencies as noted above for Jung. That is, Nishi is cited for a polymer that contains oxonorbornyl group, as noted at pages 9-10 of the application.

Applicants' independent claims 1 and 52 (the only independent claims rejected over Jung U.S. Patent 6,150,069) each calls for a heteroalicyclic group that is not an oxonorbornyl.

Such a heteroalicyclic group as Applicants claim is not disclosed or otherwise suggested by the Nishi document.

In view thereof, reconsideration and withdrawal of the rejection are requested.

Claims 1-2, 4-5, 23-24, 35, 41, 46, and 48-69 were rejected under 35 U.S.C. 102(e) over Choi et al. (U.S. Patent 6,517,990). The rejection is traversed.

While Applicants disagree with the rejection, a Rule 131 Declaration is being submitted under separate cover to antedate the Choi et al. citation.

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Barclay et al.  
U.S.S.N. 10/039,340  
Page 11

Respectfully submitted,



Peter F. Corless (Reg. 33,860)  
EDWARDS & ANGELL, LLP  
P.O. Box 9169  
Boston, MA 02209  
(617) 439-4444